



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

In re .

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 1, 3, 7, 8, 30 and 44 of the morning section and questions 6, 10, 11, 16, 17, 19, 25 and 28 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On August 2, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 1, 3, 7, 8, 30 and 44 and for afternoon questions 6, 10, 11, 16, 17, 19, 25 and 28. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. The claimed invention in a patent application is directed to an explosive composition "comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree." The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to "sensitize the composition." A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is "sufficient aeration entrapped to enhance sensitivity to a substantial degree." The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. However, in fact, "sufficient aeration" is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. The prior art reference:

(A) anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.

(B) does not anticipate the claim because the prior art reference does not recognize an inherent property.

(C) does not anticipate the claim because the prior art reference does not recognize an inherent function of oxygen.

(D) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.

(E) (B), (C) and (D).

The model answer is choice (A).

Choice (A) is correct as per 35 U.S.C. § 102. When a patent claims a composition in terms of ranges of element, any single prior art reference falling within each of the ranges anticipates the claim. *Atlas Powder Co. v. IRECO, Inc.*, 51 USPQ2d 1943 (Fed. Cir. 1999) (holding "[i]nherency is not necessarily coterminous with knowledge of those of ordinary skill in the art... Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art... However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition new to the discoverer." The court also held that "this same reasoning holds true when it is not a property, but an ingredient, which is inherently contained in the prior art."). (B) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent property. (C) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent

function of oxygen. (D) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent ingredient, oxygen. (E) is not the most correct answer because (B), (C) and (D) are not correct, whereas (A) is correct.

Petitioner argues that (E) is correct. Petitioner contends that the lack of showing of the degree of sensitivity to explosion in the prior art precludes anticipation and answers (B), (C) and (D) each indicate lack of anticipation. Petitioner further contends that (E), which indicates that (B), (C) and (D) are each correct is therefore the best answer.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the lack of showing of the degree of sensitivity to explosion in the prior art precludes anticipation, the question specifically states that in fact, "sufficient aeration" is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. Answer (A) specifically states that the prior art anticipates the claim because it discloses every limitation of the claim either explicitly or **inherently**. As explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, there is no reason to assume any facts regarding sensitivity beyond that indicated in the question, rendering the prior art anticipatory because the explosive nature necessarily implied sufficient sensitivity. Petitioner argues that something in addition to the aeration induced sensitivity may be present in the prior art, but this is not relevant: the prior art establishes that if the composition is explosive, sufficient aeration is present to read on the claimed sensitivity. The statement in answer (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 3 reads as follows:

3. A multiple dependent claim:

(A) may indirectly serve as a basis for another multiple dependent claim.

(B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.

(C) may directly serve as a basis for another multiple dependent claim.

(D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.

(E) (B) and (D).

The model answer is choice (E).

Choice (E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (D) is correct. Petitioner agrees with the model answer that answer (D) is correct but contends that answer (B) is incorrect because 37 C.F.R. § 1.75(c) mandates that the fee is required before the amendment is entered and answer (B) uses the permissive word “should” instead of “must” or “shall”. Petitioner concludes that answer (E) is incorrect and maintains that answer (D) is correct.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that 37 C.F.R. § 1.75(c) mandates that the fee is required before the amendment is entered, MPEP § 608.01(n) (top of p. 600-65) states that if a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. Accordingly, a fee should be paid before a multiple dependent claim is entered, rendering (B) correct. Because both (B) and (D) are correct, the statement in answer (E) is most correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

(i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;

(ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

(iii) _____;

(iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said

finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends. wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends. said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally secured to each other by a connector; and"

(E) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and"

The model answer is choice (B).

Answer (B) provides proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2, and "said connector" in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for "said connector" in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not "most broadly" complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for "said connector" in Claim 3.

Petitioner argues that none of the answers is correct and answer (D) is the best given that the question did not ask about 35 U.S.C. § 112. Petitioner argues that answer (D) is more broad than answer (B). Petitioner contends that answer (B) fails to provide antecedent basis for "said mid-point" in (iii) and is therefore incorrect. Petitioner concludes that the question did not ask about correctness related to 35 USC 112 and maintains that answer (B) is incorrect and therefore credit should be given for the most broad among all answers.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (B) fails to provide antecedent basis for "said mid-point" in (iii) and is therefore incorrect, there is no phrase "said midpoint" in (B) as (iii) and the question in (iv) specifically states "said second cutting member additionally including a pointer loop between said finger loop and said mid-point". As explained in answer (B), each of the first and second cutting means has a mid-point. Accordingly, answer (B) provides antecedent basis for the second cutting means mid-point in (iv), rendering the statement in answer (B) correct. As to

petitioner's argument that the question did not specifically ask about claims that fail to satisfy 35 USC § 112, the instructions state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. Because answer (B) is correct, no incorrect answer, including answer (D), can be the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

The model answer is choice (D).

Choice (D) is correct because MPEP § 710.02(e), pages 700-82 and 83, under the heading "FINAL REJECTION – TIME FOR REPLY" states. "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Hence, since no extension fee was paid in the fact pattern, the

time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, i.e., May 31, 2000. 37 C.F.R. § 1.192(a) recites, in pertinent part, "Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate." (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

Petitioner argues that answer (C) is correct. Petitioner contends that no practitioner would have waited until May 31 because no practitioner would have known when the advisory was mailed and May 30 terminated the 3 month period because May 29 was a federal holiday. Petitioner concludes that answer (D) is incorrect and maintains that answer (C) is correct.

Petitioner's argument has been fully considered but is not persuasive. In regard to petitioner's statement that no practitioner would have waited until May 31 because no practitioner would have known when the advisory was mailed, the question specifically asks which of the following dates is the last date for filing a Brief on Appeal without an extension of time. As explained in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. MPEP § 710.02(e), pages 700-82 and 83, under the heading "FINAL REJECTION – TIME FOR REPLY" states, "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the

amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Accordingly, May 31 is the last date for filing a Brief without an extension of time. rendering the statement in answer (D) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 30 reads as follows:

30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.

II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.

III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) I, II, and III.

The model answer is choice (C).

Selection (C) is the best answer as per MPEP § 2173.05(c), section III. (I) and (II) are incorrect since the phrase "an effective amount of voltage" has two different functions, i.e., to "protect windshield glass from cracking" and "for defrosting windshields." A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. Thus, choices (A), (B), and (D) are incorrect. (C) is correct, since the amended claim would state the function that is to be achieved. (E) is incorrect since (C) is correct.

Petitioner argues that answer (B) is correct because in the claim is not indefinite and (B) is broader than (C). Petitioner contends that the term "an effective amount" is not indefinite and therefore cannot sustain a rejection under 35 USC 112, second paragraph. Petitioner argues that there is only a single claimed function, heating, that produces two results, defrosting and preventing cracking, and therefore the claim is definite as to the function of heating. Petitioner concludes that action II is correct and therefore answer (B) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the recitation of "an effective amount of voltage" would not render the claim at issue in Question 30 to be indefinite because there is only a single function of heating, heating is not the term used in the claim. Instead the claim refers to adjusting the voltage source to an effective amount of voltage. The phrase "an effective amount of voltage" when read in light of the disclosure refers to either an effective amount of voltage to protect windshield glass from cracking (at least 0.5 volts) or an effective amount of voltage for defrosting windshields (at

least 1.0 volt). These are not merely two results from the same function. Each of these terms has a different function and range of values. If they were two results from the same function as argued by petitioner, there would be only a single range of values that happened to produce two distinct results simultaneously. The issue of indefiniteness rests on whether there are multiple different interpretations for the term "effective amount" as well as the ambiguity of the term "effective" and a lack of claimed functionality applied to the term "effective". The phrase "an effective amount" has been held to be indefinite when the claim fails to state the function which is to be achieved and more than one effect can be implied from the specification or the relevant art. *In re Fredericksen* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). Accordingly, the phrase "an effective amount of voltage" is indefinite because the claim fails to state the function which is to be achieved and more than one effect can be implied from the specification, rendering action I, which is premised on the claim not being indefinite, incorrect. The statement in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 44 reads as follows:

44. Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) Entering into an agreement with your client to limit the amount of any damages which your client may collect for any mistakes you make during prosecution of your client's patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging your client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the client's interest when arguing the patentability of claims in a patent application.

(D) In reply to an Office action, stating honestly and truthfully in the remarks accompanying an amendment that you have personally used the device and found it to be very efficient and better than the prior art.

(E) Investing the funds your client advanced for your legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

The model answer is choice (B).

Selection (B) is the best answer as per 37 C.F.R. § 10.87. As to (A), practitioner may not limit damages under 37 C.F.R. § 10.78. As to (C), see 37 C.F.R. § 10.89(b)(1). As to (D), see 37 C.F.R. § 10.89(c)(4). As to (E), see 37 C.F.R. § 10.112(a) where client funds advanced for legal services are required to be deposited in a bank account.

Petitioner argues that answer (E) is correct. Petitioner contends that some of the funds in answer (E) may have been earned. Petitioner argues that answer (C) is incorrect if counsel does not accompany the client in negotiations. Petitioner concludes that answer (C) is incorrect and maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that some of the funds in answer (E) may have been earned and that answer (C) is incorrect if counsel does not accompany the client in negotiations, as explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, there is no reason to assume any facts regarding earnings against an advance or failing to accompany a client. Accordingly, it is improper to place advances in anything other than a bank account and it is proper to advise a client to negotiate, rendering the statement in answer (B) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith's client?

(A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.

(B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.

(C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

(D) All of the above.

(E) None of the above.

The model answer is choice (C).

Selection (C) is correct because it sets forth the modified showing discussed in MPEP § 711.03(c), item subsection II, and complies with the fact noted in MPEP § 711.03(c), subsection. I, that a petition to withdraw holding of abandonment does not require a fee. (A) and (B) are wrong because they fail to recite that each petition must be accompanied by a petition fee as set forth in 37 C.F.R. §§ 1.17(l) and (m), respectively. MPEP § 711.03(c), item subsection III. (A) is also incorrect because a mere statement that the delay was unavoidable is insufficient. Evidence is necessary showing the delay was unavoidable.

Petitioner argues that none of (A) through (C) are correct and therefore answer (E) is correct.

Petitioner argues that answer (C) fails to include a reference to the copy of the docket record required by MPEP § 711.03(c) in the petition.

Petitioner's argument has been fully considered but is not persuasive. The docket record was properly referenced in answer (C). Answer (C) explicitly states that the petition is accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Accordingly, answer (C) contains all the elements required to petition withdrawal of abandonment, rendering the statement in answer (C) correct. Answers (A) and (B) each fail to include the required fee and are incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

(A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.

(B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.

(C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.

(D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.

(E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues (E) is correct and should be given credit. Petitioner contends that a responsible attorney would give advance notice of withdrawal and (E) is the same as (B) but also reminds the applicant of their financial debt. Petitioner concludes that answer (E) is also correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to give advance notice of withdrawal, the answer (E) specifically states that the attorney advises the applicant that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO. Answer (E) is more than a notice, it is a statement of intended action and Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. Given that no action is required and a registered practitioner would know not to threaten to withdraw representation in the absence of a PTO permission, the statement in answer (B) is correct and the statement in

answer (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 11 reads as follows:

11. Which of the following is **true**?

- (A) The differences between a continuation application and a continuation-in-part (C-I-P) application include: (1) new matter can be added when a C-I-P is filed and (2) the inventive entity in an original application and continuation application must be the same, whereas only one common inventor is necessary between an original application and a CIP application.
- (B) A reissue applicant's failure to timely file a divisional application is error and proper grounds for filing a reissue application.
- (C) A patent claiming a process is shown to be inoperative by showing no more than that it is possible to operate within the disclosure of the patent without obtaining the alleged product.
- (D) Where appeal to the Board of Patent Appeals and Interferences is dismissed for failure to argue a ground of rejection involving all the appealed claims, but allowed claimed remain in the application, the application becomes abandoned.
- (E) None of the above.

The model answer is choice (E).

As to (A) continuation need only have one inventor in common. MPEP 201.07. As to (B), failure to timely file a divisional application is not considered "error" and proper grounds for filing a reissue application. MPEP 1402. As to (C), "since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969)." MPEP 716.07. As to (D), the application is not abandoned. MPEP 1215, page 1200-36.

Petitioner argues that answer (A) is correct. Petitioner contends that the first half of (A) is correct and therefore (A) is the better answer than (E).

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that (A) is correct because half of (A) is correct, the question specifically asks which of the following is true. Accordingly, half of (A) is incorrect, rendering (A) false. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

(A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.

(B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

(C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.

(D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.

(E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the examined point. Petitioner argues that the silence in the MPEP on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation

Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)."

Monarch Knitting stated "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art" at 1983, referring to *Merck*.

Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

Afternoon question 17 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application

could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

17. With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) To encourage prompt disclosure of inventions to the public, the PTO always awards priority to the first to file an application, in this case Billie.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 1999 and actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (D) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 1999 and her patent filing in December 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

The model answer is choice (B).

Selection (B) is the correct answer as per 35 U.S.C. § 102(g); MPEP § 2138.01; *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (A) was correct, there would be no need for interference proceedings. Statement (C) is incorrect because Debbie need not establish diligence for the period from February 1999 until just before Billie's conception on May 15, 1999. Statement (D) is incorrect. Debbie needs to show diligence only from May 14th to her actual reduction to practice in June. Debbie is not required to show diligence between actual reduction to practice and her subsequent constructive reduction to practice in December 1999, so

long as she has not abandoned, suppressed or concealed the invention. 35 U.S.C. § 102(g). Statement (E) is inconsistent with 35 U.S.C. § 102(g).

Petitioner argues that (E) is also correct if Debbie was not diligent at least as early as May 14, 1999. Petitioner contends that (E) should also be given credit.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that (E) is also correct if Debbie was not diligent at least as early as May 14, 1999, the instructions specifically state do not assume any additional facts not presented in the questions. Accordingly, there is no reason to assume Debbie was not diligent at least as early as May 14, 1999, given (E)'s statement that Debbie was diligent in reducing her invention to practice, rendering (E) incorrect. The statement in answer (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 19 reads as follows:

19. Which of the following is **true**?

(A) A final decision by a United States District Court finding a patent to be invalid will have no binding effect during reexamination since the PTO may still find the claims of the patent to be valid.

(B) A final decision by a United States District Court finding a patent to be valid will have no binding effect during reexamination since the PTO may still find the claims of the patent to be invalid.

(C) Once the Court of Appeals for the Federal Circuit determines that the claims of a patent are valid, the USPTO may not find such claims invalid based upon newly discovered art.

(D) If a patentee fails to disclose prior art to the PTO during regular prosecution, the only way that a patentee can disclose later discovered prior art to the PTO after issuance is by filing a request for reexamination.

(E) Once a patent claim is found valid during a District Court Proceeding then the patent claims are entitled to a higher standard of patentability and the presumption of validity can only be rebutted by clear and convincing evidence in a concurrent or later reexamination proceeding.

The model answer is choice (B).

(B) is the most correct answer. As to (A) and (B) see MPEP 2286, page 2200- 97, stating, "[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination." Thus, (A) is incorrect because a final holding of invalidity is binding on the PTO. As to (C), the PTO may discover new art and find claims unpatentable as that art would raise a substantial new question. MPEP §§ 2216 and 2286. As to (D), the patentee could file a prior art statement under 35 U.S.C. § 301, or disclose prior art in reissue application if the original patent (through error without deceptive intent) is defective or claims more or less than should be claimed. As to (E), preponderance of evidence standard does not change in reexamination proceedings. MPEP 2286.

Petitioner argues that (D) is also correct. Petitioner contends that if a patentee fails to disclose prior art to the PTO during regular prosecution, the only way that a patentee can disclose later discovered prior art to the PTO after issuance is by filing a request for reexamination.

Petitioner states that art may only be placed in the file during reissue where a patent owner can make a declaration, which the facts given do not support, and that 35 U.S.C. 301 submissions do not actually make a disclosure to the Office, but merely place art in the file. Petitioner concludes that answer (D) is also correct and should be given credit.

Petitioner's argument has been fully considered but is not persuasive. In regard to petitioner's contention that statement in (D) is true, reexamination is NOT the only way that a patentee can disclose a new prior art to the PTO after issuance. As stated above, the patentee could disclose prior art in a reissue application or file a prior art statement under 35 U.S.C. 301. Petitioner's argument assumes that the patent owner is unable to make a reissue declaration. Furthermore, 35 U.S.C. 301 is a disclosure to the Office because the citation of the prior art will

become a part of the official file of the patent. Accordingly, answer (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 25 reads as follows:

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp, automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

The model answer is choice (B).

Selection (B) is correct as per MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are

incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of the power of attorney. 37 C.F.R. § 1.36. Thus, (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

Petitioner argues that I is also correct and therefore answer (D), the answer stating that I and II are correct, is the best answer. Petitioner contends that the PTO does not have the capacity to know whether an in-house counsel has the authority, and therefore I is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the PTO does not have the capacity to know whether an in-house counsel has the authority, the facts given in the question specifically state that Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp. The instructions explicitly state to not assume any additional facts not presented in the questions. The factual basis for the question states that Joe lacks authority. Further, 35 U.S.C. § 31 states that the Commissioner may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office. Accordingly, the question is not premised on state law, but rather PTO rules and regulations, rendering I incorrect. The statement in answer (B) is correct because II is correct, but not I. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is **true**?

(A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.

(B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).

(C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.

(D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (A) is correct and (E) is incorrect. Petitioner contends that answer (A) does not say that there are any common grounds of rejection. Petitioner argues that answer (A) is correct when different grounds of rejection are applied to different claims.

Petitioner also argues that answer (E) is incorrect because MPEP § 201.14(b) makes the location of the claim to foreign priority permissive rather than mandatory. Petitioner concludes that answer (E) is incorrect and maintains that answer (A) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that when desiring to claim foreign priority, the oath or declaration in a reissue application need not claim foreign priority even though the priority claim was made in the original patent, 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

As to answer (A), that answer states each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover. This answer states that it is sufficient to point out differences to have claims stand or fall separately. As shown in the model answer, this is not sufficient, rendering answer (A) incorrect. Whether a common ground of rejection is applied is not relevant. 37 CFR 1.192(c)(7) does not speak to whether different rejections are applied, and if appellant fails to argue such rejections in subsequent sets of claims, then the subsequent claims will stand or fall with precedent claims. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000) (The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in

grading and preclude[s] unfair and individually discriminatory grading.” *Id.*, slip opinion at 5.

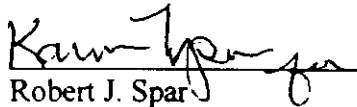
The court concluded that “the decision of the Commissioner of the USPTO not to regrade Mr. Worley’s examination answers as correct when the answers did not conform with the USPTO’s Model Answers was not arbitrary and capricious.” *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is remains 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.


Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy